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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/637,802 05/08/96 ECCLES A C-35469

DVORAK AND TRAUB
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CHICAGO IL 60604

IM22/1116

EXAMINER

SHEEHAN, J

ART UNIT	PAPER NUMBER
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1742

23

DATE MAILED:

11/16/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/637,802

Applicant(s)

Eccles

Examiner

John P. Sheehan

Group Art Unit

1742



☒ Responsive to communication(s) filed on Sep 7, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-4, 6-15, and 17-23 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-4, 6-15, and 17-23 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 to 4, 6 to 15 and 17 to 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bernard et al. '479** taken in view of **Rateau et al.** (Great Britain patent document 2,255,348).

Bernard et al. '479 teaches reduced fire scale silver-copper alloys (column 2, lines 24 to 34) consisting essentially of, in weight percent,

silver	89.3 to 93.5%
copper	0.5 to 6%
zinc	0.5 to 5%
silicon	0.1 to 2%
boron	0.001 to 2%
tin	0.25 to 2%
indium	0.01 to 1.25.

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This alloy is made by alloying silver with a master alloy (column 2, lines 34 to 37) consisting essentially of, in weight percent,

silicon	0.9 to 30.7%
boron	0.001 to 30.7%
zinc	4.5 to 76.9%
copper	4.5 to 92.3%
tin	2.2 to 30.7%
indium	0.09 to 19.2%.

Rateau et al. teach that adding 0.5 to 3 % weight germanium to a silver-copper alloy (page 3, lines 2 to 8 and page 4, lines 1 to 5) improves the hardness of the silver-copper alloy (see, for example, page 5, lines 11 to 13, page 6, Table II, Alloys 3 and 4).

The claims and Bernard et al. '479 differ in that Bernard et al. '479 do not teach the exact proportions for each of the alloy components nor does Bernard et al. '479 teach the use of Ge.

However, one of ordinary skill in the art at the time the invention was made would have been motivated to add Ge to Bernard et al. '479's alloy so as to improve the hardness of the resulting alloy as taught by Rateau et al.

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Response to Arguments

3. Applicant's arguments filed September 7, 1999 have been fully considered but they are not persuasive.

Applicants' arguments that neither of the references teaches adding Ge to a fire scale resistant silver alloy to improve hardness is not persuasive. Rateau et al. teach that adding Ge to silver alloys improves the hardenability of silver alloys (page 5, lines 11 to 13 and page 6, Table II, Examples 3 and 4). One of ordinary skill in the art would be motivated to add Ge to silver-copper alloys including silver-copper fire scale resistant alloys to improve hardenability of the alloy. The fact that the Ge further improves the fire scale resistance of fire scale resistant alloys is not a reason that would discourage one of ordinary skill in the art from adding Ge to improve hardenability of fire scale resistant alloys. The fact that Rateau et al. add Ge to silver-copper alloys to improve both fire scale resistance and hardenability whereas applicants are adding the Ge to improve only the hardenability of the alloy is of no patentable moment. Rateau et al. recognized the fact that the addition of Ge to silver-copper alloys improves both the hardenability and the fire scale resistance. Applicants' lack of appreciation for the fact that Ge improves both the fire scale resistance and the hardenability of a silver-copper alloy does not entitle applicants to a patent.

4. As set forth in the previous Office action the declaration by Melvin Bernard under 37 CFR 1.132 filed December 16., 1998 is insufficient to overcome the rejection of claims 1 to 4, 6

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to 15 and 17 to 23 based upon Bernard et al. '479 taken in view of Rateau et al. as set forth above in the instant Office action because:

I. The declaration state(s) that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no showing that persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references and still were unable to solve the problem. See MPEP §716.04.

II. In the first line on page 2 of the declaration, United Precious Metal is described as "the licensee" of the instant patent application. The Examiner questions whether United Precious Metal is the only licensee of the instant application or whether United Precious Metal is the exclusive licensee of the instant application. In order to fully evaluate Mr. Bernard's declaration it is essential that the Examiner be made completely aware of whether United Precious Metal is the only licensee of the instant application or whether United Precious Metal is the exclusive licensee of the instant application so that it is apparent what Mr. Bernard's direct or indirect interest is in the instant application.

III. There is not a consistent nexus between the instantly claimed alloy composition and the silver alloy(s) discussed in the declaration. On page 4 of the declaration the instantly claimed alloy composition is listed. It is stated that, "This new silver alloy is referred to further in this declaration as the 'Apecs Silver Alloy'." However, this exact phrase, Apecs Silver Alloy, does not appear in the declaration again. Instead, variants of the phrase are used, for example,

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“[t]his new Apecs silver alloy” (page 4, last paragraph, last sentence), “present invention” (page 5, line 3), “claimed invention” (page 5, last paragraph, first line), “claimed invention” (page 6, line 1 and paragraph 2, line 1) and “Apecs silver alloy” (page 6, lines 9, 13, 15 and 20).

In view of the use of these various terms and not the consistent use of the term “Apecs Silver Alloy” it is not clear that Mr. Bernard is actually referring to the “Apecs Silver Alloy” as defined on page 4 of the declaration which definition is the same alloy as the instantly claimed alloy, MPEP 716.03(a).

III. Much of the declaration is Mr. Bernard’s opinions, for example:

-- “The silver alloys of the claimed invention have enjoyed a wide degree of acceptability for their silver color,...and other fine silver application” (page 2, paragraph 1, the last sentence)

-- “In my opinion” (page 5, last paragraph; page 6, paragraphs 1, 3 and 4)

-- The statements made on page 6, paragraph 2.

However, there is no probative evidence to support Mr. Bernard’s opinions, MPEP 716.01(c).

The Examiner’s Response to Applicants’ Comments Regarding Mr. Melvin Bernhard’s Declaration

5. Although Mr. Bernhard may be a person of ordinary skill in the art, his opinions, as set forth in his declaration, must be supported by probative evidence, MPEP 716.01(c). As to what the Examiner would consider to be acceptable probative evidence in support of Mr. Bernhard’s

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opinions all depends on what the opinion is that Mr. Bernhard is attempting to support and what facts he used in forming his opinion. For example, with respect to his opinion that, “[t]he silver alloys of the claimed invention have enjoyed a wide degree of acceptability”, the question is asked what are the facts that form the basis for this opinion? What ever the facts are that form the basis of Mr. Bernhard’s should be submitted as part of the declaration.

6. As to whether United Precious Metal is an exclusive licensee or not is important in the determination as whether United Precious Metal and its employee, Mr. Bernhard, are interested parties. For example, an exclusive licensee having exclusive rights precluding all others from using an invention would have a different level of interest than a licensee that is one of many licensees. MPEP 716.04, In re Tiffin, 170 USPQ 88.

Amendment to Mr. Bernard’s Declaration

The proposed amendments to Mr. Bernard’s declaration have not been entered in that a declaration is a document that is sworn to by the declarant. The proposed changes to Mr. Bernard’s declaration have not been sworn to by Mr. Bernhard. Further, the Examiner could not find a provision in either the Rules or the MPEP for amending a declaration. If applicants disagree with the Examiner’s non-entry of the proposed amendments to Mr. Bernard’s declaration applicants are requested to cite the Rule or the MPEP section on which they are relying in attempting to amend Mr. Bernard’s declaration.

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Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

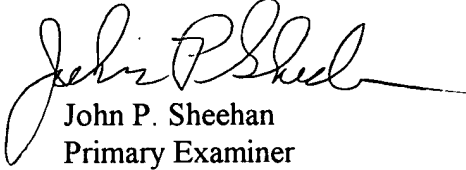
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner John P. Sheehan, whose telephone number is (703)-308-3861. The examiner can normally be reached on Tuesday-Friday from 6:30 A.M.-5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Mr. Prince Willis, can be reached on (703)-308-3050. The fax phone number for this Technology Center is (703)-305-3599.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

When filing a FAX in Technology Center, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

jps
November 12, 1999


John P. Sheehan
Primary Examiner
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